

DISCUSSION OF THE AMENDMENTS

The Specification is amended to correct the minor typographical error.

Claims 1-7 are pending. Claim 7 has been withdrawn from consideration. Claims 4, 5, and 6 are amended. Claim 4 is canceled without prejudice. Claims 8-10 are added. Support for the amendment to Claim 1 is found in the Specification spanning pages 11 – 15, when read in light of Fig. 1 and original Claim 4. Claim 5 is amended to reflect the amendment to Claim 4. Support for the amendment to Claim 6 is found page 8, lines 21-23 and page 9, lines 14-18. Claim 8 is supported by the text on page 14, lines 9-15. Claim 9 is supported by the text on page 31, lines 13-14. Claim 10 is supported by the text on page 26, lines 8-25 and page 31, lines 15-19. No new matter is believed to be added upon entry of the amendment. Upon entry of the amendment, Claims 1-3 and 5-10 will remain pending.

Claims 1-3, 5-6, and 8-10 will remain under consideration, while Claim 7 remains withdrawn.

REMARKS

Applicants thank Examiner Koslow for conducting the kind and courteous discussion with Applicants' representative, Daniel R. Evans on October 17, 2005. The content of the discussion is reflected in the amendments to the claims and the following remarks.

The rejections of any one of Claims 1-6 under 35 U.S.C. § 102(b) over JP 2001-81406 (JP '406) and JP 2000-339678 (JP '678) and under 35 U.S.C. § 103(a) over any combination of JP '678, JP '406, US '395, US '612, US '721, and US '160 are respectfully traversed.

As discussed with the Examiner, the presently claimed process is unlike the processes disclosed in JP '406 and JP '678 because these disclosures do not disclose or suggest a preliminary dispersion step as presently claimed. Applicants ask that the Examiner consider the text of JP '406 (¶¶: 26-29) and of JP '678 (¶¶: 15-16 see also Drawing 1). The same is believed to be true of the disclosures of US '395, US '612, US '721, and US '160, which have been relied upon only to suggest the shape of the ferromagnetic metal powders is acicular (see July 26, 2005 Office Action, page 6). Accordingly, it is believed that the presently claimed process is patentably distinct over the references of record. Applicants respectfully request that the Examiner acknowledge the same and withdraw these rejections.

The provisional rejection of Claims 1-5 under 35 U.S.C. § 102(e) over copending Application No. 10/446,847 (US '847) and the rejection of Claim 1-5 under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2004/0013795 (US '795) are respectfully traversed.

It is noted that US '795 was published on January 22, 2004. The present application was filed on January 28, 2004. Therefore, US '795 may be available as prior art under 35 U.S.C. § 102(a). It is also noted that US '795 is the publication of US '847 which was filed on May 29, 2003. However, the present application claims priority to JP 2003-018540 (JP '540), which was filed in the Japanese Patent Office on January 28, 2003. Applicants file

Application No. 10/765,139
Reply to Office Action of July 26, 2005

concurrently herewith an English translation of JP '540. Applicants request that the Examiner acknowledge Applicants perfection of priority. With the perfection of priority, neither US '847 nor US '795 are available as prior art under any subsection of 35 U.S.C. § 102. It is respectfully requested that the Examiner acknowledge the same and withdraw these rejections.

The rejection of Claim 6 under 35 U.S.C. § 112, second paragraph, is believed to be obviated by amendment.

It is respectfully requested that the Examiner acknowledge the same and withdraw this rejection.

Applicants file concurrently herewith a substitute Declaration that is believed to be in compliance with 37 C.F.R. § 1.63 and the U.S. Patent Office guidelines (MPEP § 605.03).

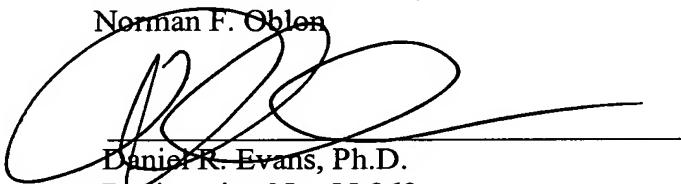
The Office has indicated that the references cited in the **Information Disclosure Statements** filed April 28, 2004 and October 19, 2004 (10/895,846 and 10/446,847) have not been considered. Applicants note that the Examiner has acknowledged consideration of the subject matter of 10/446,847 (see July 26, 2005 Office Action, pages 4-5). Applicants respectfully requests that the Examiner consider the subject matter of 10/895,846 and provide an indication of the same by including a one-sentence acknowledge in the next Office Communication.

In view of the amendments to the claims, Applicants perfection of priority to JP '540, and the remarks contained herewith, it is believed that the present application is now in a condition for allowance. Should the Examiner deem that a personal or telephonic interview would be helpful in advancing this application toward allowance, she is encouraged to contact Applicants' undersigned representative at the below-listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



Daniel R. Evans, Ph.D.
Registration No. 55,868

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)